



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/779,911	02/17/2004	L. Ross Allen	47911/269346	8986
826 7590 01/23/2008				
ALSTON & BIRD LLP				
BANK OF AMERICA PLAZA				
101 SOUTH TRYON STREET, SUITE 4000				
CHARLOTTE, NC 28280-4000				
EXAMINER				
PAINTER, BRANON C				
ART UNIT		PAPER NUMBER		
3633				
MAIL DATE		DELIVERY MODE		
01/23/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/779,911

Applicant(s)

ALLEN, L. ROSS

Examiner

BRANON C. PAINTER

Art Unit

3633

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2007.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
4a) Of the above claim(s) 8 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-7 and 9-25 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 17 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 6 recites the limitation "the stop." There is insufficient antecedent basis for this limitation in the claim. For the purpose of this examination, the examiner presumes that "the stop" refers to "stop" 28 in Fig. 3.
3. Claims 7 and 17 are rendered indefinite by the phrase "an edge portion opposite each of the first and second flanges." It is unclear whether one edge is being claimed that is opposite both the first and second flanges, or whether two edges are being claimed, one being opposite the first flange and one being opposite the second flange. For the purpose of this examination, the examiner presumes that two edges are being claimed. Further clarification is necessary.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-4, 10, 12-14, and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Givens (U.S. Patent No. 6,681,530).

6. Regarding claim 1, Givens discloses a kick-out flashing having all of the applicant's claimed structure, including:

- a. "a flat, impervious roof portion configured to be disposed on the roof..."
("second panel" 53, Fig. 2).
 - i. The examiner further notes that the term "impervious" is considered functional language, as a structure can be pervious to one thing but impervious to another (e.g., a flashing with a nail hole is pervious to moisture, but impervious to a bowling ball). As the claim currently reads, if the prior art is impervious to anything of any size, it meets the claim limitations.
- b. "...first and second flanges extending perpendicularly from respective edges of the roof portion and joined to each other to define a continuous passage extending along an intersection of the roof portion to each of the flanges...the first and second flanges defining an obtuse angle therebetween..." ("third & first panels" 54 and 52, Fig. 2).
- c. "...wherein the first and second flanges are substantially equal in size such that the flashing is substantially symmetric about a plane bisecting the obtuse angle between the flanges such that the flashing is configured to be installed in either of two alternative orientations and with either of the first and second flanges disposed against the wall with the other flange being configured to direct water flowing along the passage away from the wall." ("third & first panels" 54 and 52, Fig. 2; amended Fig. 2.1).

- i. The examiner notes that as claimed, any plane may be chosen that bisects the flashing (divides the flashing into two equal or nearly equal parts). Furthermore, the claim merely requires the two resulting flashing sections to be "substantially" symmetric. This clearly suggests that something less than exact symmetry is required. As the two sections shown in amended Fig. 2.1 are substantially symmetric, they meet the limitations of the claim.
- ii. The examiner further notes that the flashing is capable of being turned so that "third panel" 54 abuts a vertical wall to the right of the roof, with "first panel" 52 directing flowing water away from the roof-wall interface. Since the flashing of Givens is capable of being arranged in the two alternate orientations described, it meets the claim limitation "configured to be installed...the wall."
- d. The examiner notes that applicant has not positively claimed disposition of either the first or second flange against a wall. Rather, only the capability to be disposed against a wall has been claimed. Both flanges disclosed by Givens are inherently capable of being disposed against a wall, therefore the structure disclosed by Givens meets all claimed limitations.

7. Regarding claims 10 and 21, Givens discloses a kick-out flashing as set forth above, and further including:
 - a. "a vertical wall..." ("side wall" 47, Fig. 2).
 - b. "...a roof extending in a direction perpendicular to the wall and defining an interface with the wall..." ("roof" 46, Fig. 2).
 - c. "...a flashing disposed at the interface of the wall and the roof..." ("kick-out flashing" 44, Fig. 2) [claim 10].
 - d. Regarding claim 21, the combination renders the claimed method steps obvious since such would be the logical manner of using the combination.
8. Regarding claims 2 and 12, Givens discloses flanges that each define a planar outer surface directed away from the passage ("third & first panels" 54 and 52, Fig. 2).
9. Regarding claims 3 and 13, Givens discloses an obtuse angle that is between about 100 and 140 degrees ("The third panel...makes an obtuse angle of about 110° with the first panel," column 7, line 66 – column 8, line 2; Fig. 2).
10. Regarding claims 4, 14, and 23, Givens discloses flashing formed from a unitary molded plastic member ("The one-piece flashing 44...can be formed of plastic in any of the ways suitable for that material," column 8, lines 23-26; "Alternatively, the whole one-piece flashing...can be molded as a single unit of plastic," column 6, lines 59-64).
 - a. Regarding claim 23, the combination renders the claimed method steps obvious since such would be the logical manner of using the combination.

- b. The examiner notes that claims 4 and 14 are considered to be product-by-process claims due to the term "molded." The patentability of the product does not depend on its method of production. Determination of patentability is based on the product itself. See MPEP 2113. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985).
- 11. Regarding claim 18, Givens discloses first and second flanges substantially equal in size such that the flashing is substantially symmetric about a plane bisecting the obtuse angle between the flanges ("third & first panels" 54 and 52, Fig. 2; amended Fig. 2.1).
 - a. The examiner notes that as claimed, any plane may be chosen that bisects the flashing (divides the flashing into two equal or nearly equal parts). Furthermore, the claim merely requires the two resulting flashing sections to be "substantially" symmetric. This clearly suggests that something less than exact symmetry is required. As the two sections shown in amended Fig. 2.1 are substantially symmetric, they meet the limitations of the claim.
- 12. Regarding claim 19, Givens discloses a roof portion and second flange that define an edge corresponding to an edge of the roof and wall ("second panel" 53 and "first panel" 52 define "intersection" 56 corresponding to intersection of the roof and wall, Fig. 2).
- 13. 103:

Art Unit: 3635

14. Regarding claims 11 and 22:

- a. Givens discloses a fastener to connect the flashing to the wall ("The holes 26 permit a roofing adhesive or mastic to extend through base 12 and form a continuous bond between the base 12 and adjacent shingles," column 2, lines 45-47) [claim 11].
- b. The combination renders the claimed method steps obvious since such would be the logical manner of using the combination [claim 22].

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

17. Claims 5-6, 15-16, and 24 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Givens (U.S. Patent No. 6,681,530) in view of Hunter (U.S. Patent No. 5,894,697).

18. Regarding claims 5-6 and 15-16:

- a. Givens discloses a kick-out flashing as set forth above.
- b. Givens does not expressly disclose a stop extending between the first and second flanges forming a channel with the roof portion [claims 5, 15], or that the stop is smaller than the roof portion and disposed between about $\frac{1}{4}$ to 1 inch from the roof portion [claims 6, 16].
- c. Hunter discloses a stop extending between the first and second flanges forming a channel with the roof portion ("double-crimp lip guide" 15, Fig. 2C) [claims 5, 15], and that the stop is smaller than the roof portion and disposed between about $\frac{1}{4}$ to 1 inch from the roof portion ("double-crimp lip guide" 15, Fig. 2C; "There is a longitudinal double-crimp lip guide 15 in the vertical portion 12' approximately one inch above the juncture 11' with vertical portion 12'," column 2, lines 62-64) [claims 6, 16]. Adding a stop as taught by Hunter allows siding to be installed one inch above the roof shingles, preventing moisture from absorbing into the bottom edge of the siding and causing it to rot. When adding this stop, it would be obvious to extend it between the two flanges of Givens, rather than have the stop only on one flange, since either flange may be disposed against a wall as discussed above.
- d. The examiner further notes motivation for combining the references as set forth in Hunter: "This double-crimp lip...provides a predetermined separation of the siding being installed from the roof. This, of course, aids the installer

(not shown) to correctly cut the siding and to fit the same accurately along its terminal edge" (column 2, line 65 - column 3, line 2).

- e. Givens and Hunter are analogous art because both are from the field of endeavor of roof flashings.
- f. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify the flashing of Givens by adding a stop extending between the two channels as taught by Hunter, in order to aid in siding installation that prevents the siding from rotting.

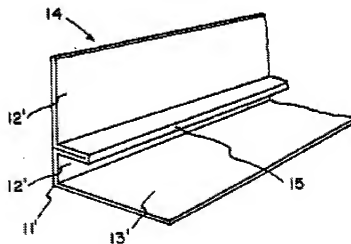


FIG. 2C

Reproduced from Hunter

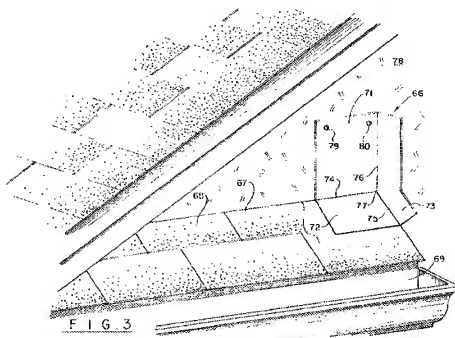
19. Regarding claim 24, the combination renders the claimed method steps obvious since such would be the logical manner of using the combination.

20. Claims 7 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Givens Embodiment A (U.S. Patent No. 6,681,530) in view of Givens Embodiment B (U.S. Patent No. 6,681,530).

- a. Givens (A) discloses a kick-out flashing as set forth above.
- b. Givens (A) does not expressly disclose a roof portion with edge portions opposite each of the first and second flanges, the edge portions extending parallel to their respective passages to define an obtuse angle equal to the angle between the flanges.
- c. Givens (B) discloses a roof portion ("panel" 73, Fig. 3) with edge portions opposite each of the first and second flanges, the edge portions extending parallel to their respective passages to define an obtuse angle equal to the angle between the flanges (both "edge" portions, amended Fig. 3). Shaping the roof portion of Givens (A) ("second panel" 52, Fig. 2) to include a second edge portion as taught by Givens (B) would provide a wider path for water traveling into the gutter. Currently, the shape of the roof portion of Givens (A) channels all water towards "lower corner" 61. In heavy rainfall, the volume of water flowing to this point may be so great and swift that some water is projected out of the gutter. The wider path provided by the shape of Givens (B) would lessen or eliminate that problem. Amended Fig. 2.2
- d. Givens (A) and Givens (B) are analogous art because both are from the field of endeavor of roof flashings.

Art Unit: 3635

- e. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify the roof portion of (A) by reshaping it as taught by "panel" 73 of (B), in order to provide a wider path for water traveling into the gutter.



Reproduced from Givens

22. Regarding claims 9 and 20:

- a. Givens discloses a kick-out flashing as set forth above.
- b. Givens does not expressly disclose that each of the flanges has a height of at least about 3 inches [claims 9, 20].
- c. There is no invention in merely changing the shape or form of an article without changing its function except in a design patent. *Eskimo Pie Corp. v. Levous et al.*, 3 USPQ 23.
- d. The examiner further notes that it would have been an obvious matter of design choice to modify the flanges by making them about 3 inches high, since applicant has not disclosed that this specific flange height solves any stated problem or is for any particular purpose and it appears that many other flange heights would perform equally well.

23. Regarding claims 11 and 22:

- a. Givens discloses a kick-out flashing as set forth above, including "nail holes" 62, 63.
- b. Givens does not expressly disclose a fastener connecting the flashing to the wall [claims 11, 22].
- c. Givens discloses the claimed invention except for nails or other fasteners inserted in the nail holes to fasten the flashing to the wall. It would have been exceedingly obvious to one having ordinary skill in the art at the time the invention was made to use fasteners to connect the flashing to the wall, since Givens discloses nail holes through which nails or other fasteners are

meant to be inserted. The examiner takes Official Notice that it is notoriously well-known to insert nails (or other fasteners) into nail holes in order to connect two abutting members. Furthermore, the selection of any fastening means such as nails, screws, adhesives, or the like would be within the level of ordinary skill in the art.

24. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Givens (U.S. Patent No. 6,681,530) in view of McGady (U.S. Patent No. 5,077,943).

- a. Givens discloses a kick-out flashing as set forth above, including a roof portion and second flange that define an edge corresponding to an edge of the roof and wall ("second panel" 53 and "first panel" 52 define "intersection" 56 corresponding to intersection of the roof and wall, Fig. 2).
- b. Givens does not expressly disclose that the flashing is trimmed when defining this edge.
- c. McGady discloses flashing that is trimmed ("experienced roofers or tinsmiths were required to...provide on the job custom fitted flashing pieces attempting to seal the corner at the roof line. These hand cut or trimmed flashing pieces," column 1, lines 22-28). Trimming the flashing pieces of Givens as taught by McGady assures that the flashing pieces conform to the intersection of the roof and vertical wall.
- d. Givens and McGady are analogous art because both are from the field of endeavor of roof flashings.

- e. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify the flashing of Givens by trimming as taught by McGady, in order to ensure the flashing conforms to the intersection of the roof and vertical wall.
- f. Regarding claim 25, the combination renders the claimed method steps obvious since such would be the logical manner of using the combination.

Response to Arguments

25. Applicant's arguments with respect to claims 1-25 have been considered but are moot in view of the new ground(s) of rejection.
26. In applicant's arguments, it is suggested that Hunter serves a materially different function than Givens because its elongated guide is used to properly cut and install siding the correct distance from the roof. The examiner notes that the invention of Hunter still functions primarily as roof flashing, a fact made evident by the title ("Flashing for Siding") and the description of the member ("flashing" 14), along with the rest of the disclosure. Since Givens and Hunter both function as roof flashing, it is certainly within reason to combine them.

Conclusion

27. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Art Unit: 3635

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRANON C. PAINTER whose telephone number is (571)270-3110. The examiner can normally be reached on Mon-Fri 7:30AM-5:00PM, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on (571) 272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Richard E. Chilcot/
Supervisory Patent Examiner, Art Unit 3635

/B. C. P./
Examiner, Art Unit 3633
01/15/08